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OCT 07 2005**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Ernest Heinz
Serial No.: 10 / 771,531
Filed: February 4, 2005
Title: Disposable Plate System

October 7, 2005

Group Art Unit: 3727
Examiner: Harry A. Grosso

HON. COMMISSIONER OF PATENTS AND TRADEMARKS
WASHINGTON, D.C. 20231

RESPONSE TO FIRST OFFICE ACTION

This paper is in response to an Office Action dated June 30, 2005.
Please amend the claims as shown in the attached "CLAIM AMENDMENTS".

COMMENTS

The Examiner first notes that the application contains claims directed to patentably distinct species of the invention and refers to Figure 1 which utilizes "tabs" (Claims 1 - 15) and Figure 2 which utilizes "notches" (Claims 16 & 17). As mentioned by the Examiner, in a June 13, 2005 telephone conversation between applicant's attorney and the Examiner, the applicant provisionally elected the species utilizing the notches shown in Figure 2 and claimed in claims 16 & 17. The applicant hereby formally elects the species shown in Figure 2 and claimed in claims 16 & 17. Accordingly, the applicant has cancelled claims 1 - 15.

The Examiner then rejects claim 16 under the 2nd paragraph of 35 USC 112 stating that there is insufficient antecedent basis for the term "the notch" in line 5 of the claim. The applicant has amended claim 16 to correct this matter. The word "notch" has been deleted and replaced by the word "cutout" which is properly introduced in line 4 of claim 16.

Next, the Examiner rejects claim 16 under 35 USC 102(a) "as being anticipated by Nagy (6,561,375). Nagy discloses a plurality of disposable plates (Figure 3, column 3, lines 64-66)

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with a flat central portion (26) and a raised rim (24) with a cutout in the outer edge of the rim (44, Figure 4, column 5, lines 19-20) adaptable to assist in separating the plates."

The applicant respectfully disagrees with the Examiner. At column 3, lines 64 - 66 we read: "The dishes are normally intended to be used one time and recyclable with normally the dishes to be constructed of paper, plastic, polystyrene or foam." The only similarity with the applicant's invention is that the dishes are to be used one time and they are constructed of the same materials.

Nagy '375 does teach an opening 44 which is described in detail at col. 5, lines 17 - 32 which is reproduced immediately below.

"Referring particularly to FIG. 4 of the drawings, there is shown a modified form of plate 42 which is basically similar to plate 20 and like numerals have been utilized to refer to like parts. However, included within the annular support flange 28 is an opening 44. The opening 44 has flared ends 46 and 48. The idea of the flared ends 46 and 48 is to produce a thin slit at each end of the opening 44 that will facilitate the insertion and locking in place of an exterior structure, such as a napkin 50. Also, the flared ends 46 and 48 could be used to lock in place a utensil, such as a knife, fork or spoon where the utensil is constructed to be light in weight, usually of plastic. The optional opening 44 can be formed either by means of a mold in the case that the new SPILL RESISTANT DISHWARE will be molded from a paper slurry, plastic or foam or by cutting the opening 44 into a "blank" used to make the dishware by means of a die press."

From this we can see that the purpose of opening 44 is for holding a napkin and utensils, and for no other purpose. In addition, plate 20 of Nagy has a central food receiving area 22 which has an annular shaped edge 24 which is the raised edge of the plate and is equivalent to the applicant's raised edge 12. See page 5, lines 9 - 15 in the applicant's specification and Figure 2. The applicant places his notch or cutout 15 "in the periphery of its raised edge 12". For resistance against being blown away by the wind Nagy adds an "annular support flange 28" to the outer edge of the annular shaped edge 24. A low tack adhesive is added to the edge of this flange 28 to stick the plate to a surface.

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The applicant has amended claims 16 make this distinction clear. The appropriate portion of claim 16 now reads:

“a plurality of disposable plates, each plate having a substantially flat central portion surrounded by and immediately adjacent to a raised rim;
wherein each plate has a cutout in the outer edge of the raised rim,”

Further, the opening 44 in Nagy is not in its edge 24, but rather in its flange 28 which is not immediately adjacent to its central food receiving area 22. (Col. 4, l. 1 - 16). In both Nagy and the applicant's plate their raised “edge” is above the food area 22 to retain the food in this area. Nagy cannot place his adhesive 40 on the rim of the raised edge 12 because it will not contact a surface on which the plate rests to have the adhesive 40 hold the plate to the surface. Nagy requires the additional flange 28 connected to edge 24 so that the adhesive 40 on the lower edge of the flange will sit on the surface on which the plate rests.

Then the Examiner rejects claim 17 under 35 USC 103 “as being unpatentable over Nagy”. Continuing, the Examiner states that:

“Claim 17 recites that the cutout in the rim of each plate is offset with respect to the cutout in the rim of adjacent plates. Nagy discloses the plate system of claim 16 but is silent on the orientation of the cutout in the rims of the plates, however, applicant does not disclose that the orientation of the cutouts relative to each other solves any stated problem or is for any particular purpose. The plurality of plates of Nagy would be inherently capable of being stacked with the cutouts in the rims in any orientation desired relative to each other. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have stacked the plate of Nagy with the cutouts in the rims in any orientation preferred.”

The applicant respectfully disagrees with the Examiner. First, the applicant has amended claim 17 to recite the purpose of the offset of the cutouts as: “the angular offset making it easier to separate adjacent plates”. The Examiner is correct in noting that Nagy is silent on the orientation of the cutout, but is also silent about any use of the cutout other than holding napkins or utensils. There is not even a suggestion that there is a problem in separating plates such that

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the cutouts might be useful in separating the plates. Thus, the applicant contends that the Examiner's view that: "The plurality of plates of Nagy would be inherently capable of being stacked with the cutouts in the rims in any orientation desired relative to each other." is impermissible hindsight.

In the key case *In re Fine*, 837 F.2d 1074, 5 USPQ2d 1596, (Fed. Cir. 1988), the court stated:

"But whether a particular combination might be 'obvious to try' is not a legitimate test of patentability. Obviousness is tested by 'what the combined teachings of the references would have suggested to those of ordinary skill in the art', but it 'cannot be established by combining the teaching of the prior art to solve the problem of the claimed invention, absent some teaching or suggestion supporting the combination.' Here the prior art contains none. And *'teaching of references can be combined only if there is some suggestion or incentive to do so.'* Here the prior art contains none."

"Instead, the Examiner relies on hind sight in teaching his obviousness rejection. "But, this court has said, to 'imbue one of ordinary skill in the art with the knowledge of the individual, in suite, when no prior art reference or references as of record convey or suggest that knowledge is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teaching'. It is essential that 'the decision maker forget what he or she has been taught about the claimed invention and casts the mind back to the time the invention was made ... to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then accepted wisdom in the art.'"

"id. One cannot use hindsight reconstruction to pick and choose among isolated disclosures of the prior art to deprecate the claimed invention."

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Again in *Para-Ordnance Mfg., Inc. v. SGS Importers Int'l, Inc.*, 37 USPQ2d 1237 (Fed.Cir. 1995) the court stated:

"For a combination of prior art references to render an invention obvious, "there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." In *re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). That one must point to some reason, suggestion, or motivation to make a combination is not to say that the teaching must be explicit, but in order to render an invention obvious by the combination of prior art references, the record must contain some basis to rebut the presumption of validity. See, e.g., *Vandenberg v. Dairy Equip. Co.*, 740 F.2d 1560, 1568, 224 USPQ 195, 198 (Fed. Cir. 1984). A finding of obviousness on any other basis would constitute hindsight. See *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) ("When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.").

"A simple invention may be patentable, even if the invention comprises the combination of features known in the art, provided the combination itself is not obvious. See *In re Spinnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969) ("A patentable invention, within the ambit of 35 U.S.C. § 103, may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use.").

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Thus, the applicants respectfully contend that amended claim 17 is now allowable. In addition, the applicant contends that claim 17 is allowable based on its dependence from an allowable independent claim 10 - which has been amended to be allowable.

Finally, the Examiner cites Huff patent (1,938,909) which "discloses a disposable plate with a rim cutout". The applicant has reviewed this patent and believes that, similar to the Nagy patent, it does not teach or suggest, alone or in combination with Nagy patent, the applicant's invention as more clearly claimed in the amended claims.

In view of the above arguments and the amendments to the claims this patent application is now believed to be in condition for allowance and passage to issuance is respectfully requested. If there remain any matters that may be resolved by telephone the Examiner is invited and authorized to contact the undersigned attorney via telephone at (603) 432-8788, via fax at (603) 421-2779, or via e-mail at jfunk777@adelphia.net.

Sincerely,



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